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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/781,033

02/09/2001

Donald P. Gibson

36.P290

1583

5514

7590

11/14/2005

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NEW YORK, NY 10112

EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.:

09/781,033

Applicant(s)

GIBSON ET AL.

Examiner

James W. Myhre

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 1-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 23, 2005 has been entered.

Response to Amendment

2. The amendment and declaration filed on August 18, 2005 have been entered and considered. The Declaration is sufficient to overcome the Jackson et al (6,760,128) reference by changing the date of invention of the present invention to some time prior to the filing date of the Jackson reference. Since the earliest date identified in the Declaration is October 11, 2000 the Examiner will consider this to be the date of invention for the present invention. The August 18m 2005 amendment did not amend, add, or delete any claims. Thus, the currently pending claims considered below remain Claims 47-54.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 47-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Agarwal et al (6,509,910).

Claims 47 and 52: Agarwal discloses a system and method for providing digital image service, comprising:

- a. receiving digital image data from a removable storage media via an interface (col 3, lines 1-9);
- b. storing the digital image data in an electronic image database (col 3, lines 1-9);
- c. receiving advertising information (e.g. “describing different features of the albums and other photo products”) from a remote server via a network (Figure 8, item 820 and col 10, lines 24-32)
- d. storing the received advertising information in an electronic advertising database (Figure 8, item 820 and col 10, lines 24-32);
- e. receiving a request at a computer for displaying a service menu (col 15, lines 18-30);

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f. responsive to the request, sending the digital image data in the electronic image database and the advertising information in the electronic advertising database to the computer (col 15, lines 18-30); and

e. displaying, in the service menu of the computer, an image based on the digital image data, an advertisement based on the advertising information, and one or more services for printing (col 15, lines 18-30).

Claim 48: Agarwal discloses a method for providing digital image service as in Claim 47 above, and further discloses the menu includes the advertisement and thumbnail images of the image data (col 14, lines 32-40; col 17, lines 8-11; and col 20, lines 42-46).

Claim 49: Agarwal discloses a method for providing digital image service as in Claim 47 above, and further discloses the menu including selecting a size and volume of print for each of the selected image data (col 20, lines 59-64).

Claim 50: Agarwal discloses a method for providing digital image service as in Claim 47 above, and further discloses the menu includes an option to generate a storage medium containing the selected image data (col 14, lines 41-52).

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Claim 51: Agarwal discloses a method for providing digital image service as in Claim 47 above, and further discloses the image data being captured and stored on the removable storage medium of a digital camera (col 2, lines 64-66 and col 20, lines 65-67).

Claims 53 and 54: Agarwal discloses a method and system for providing digital image service as in Claims 47 and 52 above, and further discloses the digital image data and advertising information being sent to the computer via a cable head end (col 2, line 64 - col 3, line 9 and col 23, lines 17-20).

Response to Arguments

5. Applicant's arguments with respect to claims 47-54 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (571) 273-8300. Draft or

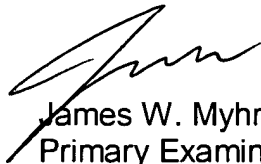
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Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.



JWM
November 9, 2005



James W. Myhre
Primary Examiner
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